

Remarks:

Applicant has studied the Office Action dated August 30, 2006. Claims 13-18, 20-26, 28-36, 38-45, 47-50, 61 and 62 are pending. Claims 13-18, 20-26, 28-36, 38-45, 47-50, 61, and 62 are rejected under 35 U.S.C. 112, first paragraph. Claims 13-18, 20-26, 28-36, 38-45, 47-50, 61 and 62 are rejected under 35 U.S.C. 102(b) as being anticipated by Chander et al. (U.S. Patent 5,909,651). The Examiner rejections are respectfully traversed. Reconsideration and reexamination are requested for the reasons provided below.

§112 Rejection(s):

The Examiner contends that the claim language reciting elements “first information” and “second information” are not supported in the specification under §112 such that “the first information indicates position of the second information in a target slot in said plurality of time slots” and “the first information and the second information are transmitted in a general page message over a single paging channel.”

Applicant appreciates the Examiner’s reference to paragraphs 10-15 and paragraphs 17-19 in support of his contention that the recited language in the amended claims is not found therein. The Examiner is, however, reminded that the paragraphs to which the Examiner refers are included in the Summary of the application, and since the Summary is generally a clean version of the claims, as filed originally, it would be obvious that amending the claims in any way would result in a change in scope that is not necessarily exactly the same as that reflected in the Summary.

While the summary may support some embodiments of the invention, the rest of the application, particularly the Detailed Description provides support for other embodiments of the invention as recited in the amended claims. Therefore, instead of looking at the Summary only, the Examiner is invited to also review the Detailed Description of the Invention that provide support for the amended claims.

The Examiner is reminded that §112, first paragraph, requires for the specification to adequately support the subject matter claimed rather than mirroring the claim language word for

word. MPEP 2163, *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116.

Support can be provided “in a variety of ways” and “using such descriptive means as words, structures, figures, diagrams, and formulas” to “show that the applicant was in possession of the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). See, e.g., *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998) (emphasis added).

Further, claim limitations may be supported in the specification through “express, implicit, or inherent disclosure.” See *In re Oda*, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971). For example, referring to paragraphs 51-56 of the Detailed Description, and particularly paragraphs 51 and 53, the concept of transmitting an SMS message in a single burst is both expressly and inherently disclosed, suggesting that information about the position of the slot containing the message and the message itself can be both included in a “general page message”:

[0051] “The mobile communication terminals, in which the paging channel is searched, recognize the arrival of the broadcasting short message by searching the paging channel of the zero slot, and receive the data burst message that includes the actual broadcasting short message at the time point of the third slot, for example.”

[0053] “a mobile communication system includes in a general page message and transmits information that informs arrival of the broadcasting short message (hereinafter referred to as first information) and information that informs a position of a specified slot of a paging channel decided to transmit the arrived broadcasting short message (hereinafter referred to as second information) using the paging channel and in accordance with a searching period preset with respect to the paging channel.”

Therefore, the recited claim elements direct to first information and second information are supported, where “first information” reads over the “position of a target slot” and the “second information” reads over the “message” transmitted in a “communication cycle.” Figure 6 further supports the claim language by illustrating a slot for a data burst message.

Referring to Figure 4, the Examiner correctly points out that the terms “first information” and “second information” refer to “arrival information” and “position information,” respectively, within that particular context. This, however, does not mean that the claim elements as drafted must refer to the same items. As the Examiner is well aware, the terms “first” and “second” when used in the claims do not connote a certain order and are basically used to distinguish the claimed elements from one another.

Contrary to the Examiner’s assertion, section §112, first paragraph does not require a word-for-word matching between the language in the specification and the language recited in the claims. If one were to interpret §112, first paragraph, according to the Examiner’s understanding, then the scope of the claim would have to be limited to what has been disclosed by *identical* language used in the specification and nothing more.

Referring to MPEP 2163 (II) (A), “[t]he examiner has the initial burden, after a thorough reading and evaluation of the content of the application, of presenting evidence or reasons why a person skilled in the art would not recognize that the written description of the invention provides support for the claims. There is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed, Wertheim, 541 F.2d at 262, 191 USPQ at 96.”

Respectfully, the Examiner has misinterpreted the claims. Pursuant to MPEP §2163 (II) (A) and §2163.04, the Examiner is requested to present “evidence or reasoning to explain why

persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims,”¹ or otherwise withdraw the rejection.

For the above reasons, the Applicant submits that the specification adequately supports the claim language. However, if the Examiner feels that another choice of words may be better for the understanding of the claims, the Applicant can reword the claims to recited “slot position data” and “message data” instead of “first information” and “second information.” The Applicant will amend the claims accordingly upon Examiner’s confirmation that such change would not require a new search, as the scope of the claims remains the same, and that no prosecution history estoppel will apply.

§102 Rejection(s):

Pending claims are rejected under sections 102 under USPN 5,909,651 (“Chander”). The rejection is respectfully traversed.

Chander is directed to a method of broadcasting “short messages” using two separate paging cycles (i.e., a Paging Slot Cycle and an additional Broadcast Paging Cycle) thus effectively the mobile stations will have to “not only wake up for their assigned . . . Paging Slot Cycle, but also for the relevant slot of the Broadcast Paging Cycle.” (See col. 3, lines 25-30). As such, Chander requires a mobile station to wake up more often, resulting in consumption of battery power at a faster rate.

In contrast, one objective of the present invention is to reduce battery power consumption, by limiting the duration and number of times a mobile station has to be awakened. This is accomplished by transmitting to the mobile station information about the position of the slot in which the message is going to be included. In this manner, the mobile station will wake up only to monitor the target slot, instead of waking up intermittently for each active slot during the Paging Slot Cycle and the Broadcast Paging Cycle, as suggested by Chander (see col. 2, Ins 35-40).

¹ MPEP § 2163.04 “If applicant ... points out where and/or how the originally filed disclosure supports the amendment(s), and the examiner finds that the disclosure does not reasonably convey that the inventor had possession of the subject matter of the amendment at the time of the

With respect to the 102 grounds of rejection, it is respectfully noted that anticipation of claims using a drawing requires that "the picture must show all the claimed structural features and how they are put together" and "[t]he drawings must be evaluated for what they reasonably disclose and suggest to one of ordinary skill in the art." M.P.E.P. §2125. Furthermore, anticipation of a claim under 35 U.S.C. §102 (a), (b) and (e) requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," that "[t]he identical invention must be shown in as complete detail as is contained in the ... claim" and "[t]he elements must be arranged as required by the claim." M.P.E.P. §2131.

Independent claims 13, 21, 31, 41, 61 and 62 recite a mobile communication network transmitting first information and second information in a communication cycle having a plurality of time slots, wherein the first information indicates position of message information in a target slot in said plurality of time slots. A mobile communication terminal searches a time slot in the communication cycle for the first information, and retrieves the second information from the target slot based on the first information. The first information and the second information are transmitted in a general page message over a single paging channel, such that the mobile communication terminal searches for the first information and the second information in a single communication cycle.

Chander fails to disclose the above elements and relationships. Particularly the Examiner has not pointed to any portion of the cited references that discloses, teaches or suggests "the first information indicates position of the second information in a target slot in said plurality of time slots." Since Chander fails to disclose at least one of the above recited elements in the amended claims, a rejection under § 102 would be improper.

Further Chander specifically teaches away from the present invention by suggesting an additional cycle in which the mobile station will have to awaken, thereby consuming extra

battery power. Since the objective of the present invention is to reduce consumption of battery power by reducing the frequency and length of time in which the mobile terminal have to awaken, Chander is an improper reference and should be withdrawn, regardless of whether or not another reference can be found to cure the deficiencies of Chander.

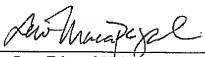
For the above reasons, the invention as recited in independent claims 13, 21, 31, 41, 61 and 62 is distinguishable over the references cited by the Examiner. Excluding canceled claims 19, 27, 37, and 46, claims 14-20, 22-30, 32-40, and 42-50 respectively depending on claims 13, 21, 31, 41 should also be in condition for allowance by the virtue of their dependence on allowable base claims.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have expressly argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,
Lee, Hong, Degerman, Kang & Schmadeka

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By: 
Lew Edward V. Macapagal
Registration No. 55,416
Attorney(s) for Applicant

Customer No. 35884